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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,719	01/18/2002	Joseph G. Buchl	43314/236950	5375
826 7590 07/09/2008 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				
EXAMINER				
IWARERE, OLUSEYE				
ART UNIT		PAPER NUMBER		
3687				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

### Office Action Summary

**Application No.**

10/054,719

**Applicant(s)**

BUEHL ET AL.

**Examiner**

OLUSEYE IWARERE

**Art Unit**

3687

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This communication is in response to the correspondence sent on April 28, 2008. The amendments to claims 1 - 7, 12 and 14 - 18 have been entered and have been considered below. Claims 8 - 11 and 13 have been cancelled. The claim objection to claim 2 has been withdrawn.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims rejected under 35 U.S.C. 102(e) as being anticipated by LaRocca et al. (2002/0023268).**

**As per claim 1**, LaRocca discloses a digital distribution and delivery system comprising a hybrid fiber coax network facilitating the provisioning and billing of a service available for purchase to a subscriber associated with a set top box subscribers ([0027] discusses a hybrid fiber-coax network), comprising:

a service application program implementing the service (fig. 3B depicts implementing the service), said service application program comprising a price algorithm and metadata both associated with a service offering (fig. 3B and [0049]

discuss pricing and metadata) wherein the service application program is configured to receive a purchase request for the service offering from the set top box and compute a list price associated with the service offering using the price algorithm, said service application program configured to generate one or more billing messages indicating an identifier of the set top box, the service offering, the list price, and the metadata (fig. 3B depicts pricing algorithm, billing messages and a PIN),

a billing system receiving said one or more billing messages, the billing system configured to generate an amount billed to the subscriber for the service offering wherein the amount billed comprises the list price and an additional amount, wherein the meta data is used by the billing system to determine the additional amount (fig. 3B and [0049] discuss generating a bill); and

a network controller configured to receive a provisioning message for provisioning the service offering for the set top box connected to the hybrid fiber coax network (fig. 3C depicts a provisioning message and [0027] depicts an HFC network).

**As per claim 4**, LaRocca further discloses comprising a marketing component, wherein said marketing component provides marketing data associated with the service offering used by to said price algorithm to determine said list price (fig. 1 depicts a network controller and fig. 3B depicts determining list price).

**As per claim 5**, LaRocca further discloses comprising:

a network controller in communication with the service application program to provision the set top box to receive digital content associated with the requested service offering (fig. 1 depicts the network controller and fig. 3B depicts receiving service).

**As per claim 6**, LaRocca discloses wherein the network controller provisions the set top box to receive said service offering (fig. 1 and fig. 3B depict provisioning to the set top box).

**As per claim 7**, LaRocca discloses wherein said network controller is capable of receiving a command from the service application program to provision the set top box (fig. 1 and fig 3B depict receiving a command).

**As per claim 12**, LaRocca discloses a method of facilitating the provisioning and billing of a service for a subscriber in a digital distribution and delivery system comprising a hybrid fiber coax network ([0027] discusses a hybrid fiber-coax network), comprising the steps of:

receiving at a service application program executing in the digital distribution and delivery system, a purchase request for a service offering comprising an indication of the service offering from a set top box connected to said hybrid fiber coax network, said service application program comprising a pricing algorithm and meta data both associated with the service offering fig. 3A depicts a purchase request and [0049] discusses pricing);

ascertaining an identification of the set top box making the purchase request as indicated in the purchase request ([fig. 3A depicts a PIN and validation];

processing the purchase request at the service application program using a pricing algorithm associated with the service offering to determine a list price of the service offering (fig. 3B depicts and (0049] discusses processing using pricing);

providing the identification of the set top box, the indication of the service offering, the list price, and the meta data to a billing system, wherein the billing system calculates a charge for the service offering for the subscriber associated with the set top box, wherein the charge comprises the list price and an additional amount (fig. 3C depicts providing billing info to the set top box); and

providing a provisioning message to a network controller provisioning the service offering for the set top box connected to the hybrid fiber coax network (fig. 3 depicts providing a message to the controller).

**As per claim 14**, LaRocca further discloses comprising the step of:

generating a bill for said subscriber at said billing system for said service offering, said bill indicating the charge wherein the charge comprises said additional amount that is calculated using said metadata (fig. 3B and ([0049] discusses generating a bill).

**As per claim 16**, LaRocca further discloses comprising the step of:

provisioning said service offering in the set top box by generating a second provisioning message conveyed over the hybrid fiber coax network from the network

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controller to the set top box (fig. 3B depicts sending information to the screen through the set top box).

**As per claim 17**, LaRocca further discloses comprising the steps of:

determining in said billing system said subscriber is authorized to receive said service offering (fig. 3C depicts authorization); and

providing from said billing system to said service application program an indication that said subscriber is authorized to receive said service offering (fig. 3C depicts providing billing subscription information).

**As per claim 18**, LaRocca further discloses comprising the step of:

instructing the network controller to distribute content associated with said offering to said set top box (fig. 3C depicts distributing content).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 2, 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaRocca et al. (2002/0023268) in view of Reeder (5,852,812).**

**As per claim 2**, LaRocca discloses the claimed invention but fails to explicitly disclose wherein the a billing system maintains at least one table comprising tax-related information associated with the service offering that is used by the billing system to determine the additional amount.

Reeder teaches a billing system for a network wherein the a billing system maintains at least one table comprising tax-related information associated with the service offering that is used by the billing system to determine the additional amount (fig. 10 depicts tax related information).

From this teaching of Reeder, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of LaRocca to include the tax-related information, taught by Reeder, in order to calculate the total bill.

**As per claim 3**, LaRocca discloses the claimed invention but fails to explicitly disclose wherein the additional amount comprises a plurality of tax amounts and the metadata comprises a plurality of billing items which are used to compute a the plurality of tax amounts.

Reeder teaches a billing system for a network wherein the additional amount comprises a plurality of tax amounts and the metadata comprises a plurality of billing items which are used to compute a the plurality of tax amounts (fig. 10 depicts a tax and billing items).

From this teaching of Reeder, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of LaRocca to



include the tax amounts and metadata, taught by Reeder, in order to calculate the total bill.

**As per claim 15**, LaRocca discloses the claimed invention but fails to explicitly disclose wherein calculating said charge for said service offering using said metadata comprises accessing at least one tax related table stored in said billing system to determine at least one tax associated with said service offering.

Reeder teaches a billing system for a network wherein calculating said charge for said service offering using said metadata comprises accessing at least one tax related table stored in said billing system to determine at least one tax associated with said service offering (fig. 10 depicts tax information).

From this teaching of Reeder, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of LaRocca to include the tax-related information, taught by Reeder in order to calculate the total bill.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1 – 7, and 12 – 18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **OLUSEYE IWARERE** whose telephone number is (571)270-5112. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/  
Supervisory Patent Examiner, Art  
Unit 3687

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